



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,715	08/22/2001	Hideaki Takahashi	SON-2200	6288
23353 7590 05/27/2009 RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036				
EXAMINER				
KAZDML HANI M				
ART UNIT		PAPER NUMBER		
3691				
MAIL DATE		DELIVERY MODE		
05/27/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/933,715

Applicant(s)

TAKAHASHI ET AL.

Examiner

Hani Kazimi

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-7, 9-12 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 9-12, and 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 10, 2009 has been entered.

Status of Claims

2. Claims 1-3, 5-7, 9-12, and 15-17 are currently pending. The rejections are as stated below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-3, 5-7, 9-12, and 15-17 rejected under 35 U.S.C. 103(a) as being unpatentable over Storey, U.S. Patent No. 6,009,412, in view of Davis, U.S. Patent No. 6,105,008, in view of Matsumoto, U.S. Patent No. 5,992,738, in view of Cybul et al., U.S. Patent No. 6,415,261, and further in view of Business World, "Citibank, Cathay Pacific launch new credit card" hereinafter *Citibank*.

Claims 1, 11, Storey teaches a communication system and method, comprising:
a first management apparatus for managing and settling a first transaction and generating a first privilege information generated in accordance with the first transaction the first transaction being a virtual transaction, the virtual transaction being a transaction conducted between the first management apparatus and a user terminal, located at a remote location, without a point-of-sale terminal via a network (column 4 line 66 – column 5 line 11, and column 5 lines 44-54), using a user identifier that identifies the user in such a manner that the first privilege information and the user identifier are correlated with each other (column 7 lines 50-60).

Storey fails to teach the use of an IC card.

Davis teaches an internet payment system using a smart card, where the user identifier is stored in a smart card and uniquely associates the user to the smart card (column 21 lines 31-57), where the transaction is made using the smart card in conjunction with the user terminal (column 10 line 59 – column 11 line 16). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Storey to include the use of the smart card as described by Davis because Storey contemplates payments, and Davis teaches using an IC card for paying for goods over the internet. The elements of the claimed invention were known at the time of Applicant's invention, and the results were predictable.

Storey and David fail to teach a second management apparatus.

Matsumoto teaches a second management apparatus for managing and settling a second transaction, the second transaction being a real world transaction, the real world transaction being a transaction conducted between the second management apparatus and the user via a point-of-sale terminal, wherein the second transaction includes a settlement processing based on the user identifier and a price, and is made using an IC card in conjunction with the point-of-sale terminal (column 8 line 26 – column 9 line 7). Matsumoto further teaches the transaction is only carried out if there is a sufficient balance, which is considered a credibility or a contribution of the user in the real world (column 4 lines 31-39). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Storey and

Davis to include the second management apparatus because Cybul teaches a system and method for managing frequent shopper programs for users who shop on-line over the internet, as well as in the physical store (abstract). Cybul teaches an in-store POS device which converts information from an internet shopping history server into information which is used to reward loyal shoppers. Based on the Cybul disclosure, one of ordinary skill in the art would appreciate the benefits of integrating an online (or virtual world) shopping system with an in-store (or real world) shopping system. Storey and Davis combine to provide an internet shopping system (such as described by Cybul in figure 1, #18) which incorporates IC cards, and Matsumoto describes a POS system (such as described by Cybul in figure 1, #12) which incorporates IC cards. Cybul provides a teaching to integrate the two systems for the purpose of a customer loyalty program which reflects all of a user's purchases, both online and offline. According to the teachings of Cybul, the second management apparatus converts the first privilege information that is managed by the first management apparatus (on-line shopping history) into privilege information managed by the second management apparatus (column 5 lines 13-38: because the e-commerce shopping history is imported and treated the same as the POS shipping history), and manages the information obtained by the result of the conversion. Examiner considers the user using the card at the user terminal to be requesting the conversion of privilege information. The first privilege information is therefore converted to the second privilege information and added to a total of the second privilege information upon the use of the card by the user (column 5 lines 35-38).

Storey, David, Matsumoto and Cybul fail to teach the conversion is based on a prescribed conversion factor.

Citibank teaches converting reward points earned under a first reward system (Citibank credit card reward points) into points managed under a second reward system (Cathay airline miles) under a prescribed conversion factor (1.5 reward points: 1 mile). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Storey, David, Matsumoto and Cybul because the references are concerned with multiple reward systems, as described above, and the conversion ability makes any reward system more marketable, and convenient to a person holding rewards with the system. The co-branding increases business with both the credit card and the airline, which is an obvious benefit to adopting such a reward conversion system.

Claims 2, 7, 15, Storey teaches the privilege information is an addable point, issued by the first management apparatus, as cited above.

Claim 3, Storey teaches the first privilege information is associated with a maximum amount of money that the user can use (column 8 lines 34-46).

Claims 5, 12, as cited above both Storey and Matsumoto teach points.

Claims 6, 10, 17, see the discussion of Matsumoto in relation to claim 1, above.

Claim 9, 16, Storey teaches the first management apparatus provides the privilege information in accordance with a credibility of the user (column 5 lines 1-43).

Response to Arguments

6. Applicant's arguments with respect to claim 1-3, 5-7, 9-12, and 15-17 have been considered but are moot in view of the new grounds of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Kesack whose telephone number is (571)272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted,

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691